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KEATING DENTAL ARTS, INC.

IN THE UNITED STATES DISTRICT COURT  
FOR THE CENTRAL DISTRICT OF CALIFORNIA  
SOUTHERN DIVISION

13 JAMES R. GLIDEWELL DENTAL  
14 CERAMICS, INC. dba GLIDEWELL  
15 LABORATORIES,  
16 Plaintiff,  
17 v.  
18 KEATING DENTAL ARTS, INC.  
19 Defendant.  
20 AND RELATED COUNTERCLAIMS.  
21

} Civil Action No.  
SACV11-01309-DOC(ANx)

} **MEMORANDUM OF POINTS  
AND AUTHORITIES IN  
SUPPORT OF  
DEFENDANT'S MOTION  
FOR SUMMARY  
JUDGMENT CANCELING  
GLIDEWELL'S  
TRADEMARK  
REGISTRATION**

} Date: December 17, 2012  
Time: 8:30 a.m.  
Location: Courtroom 9D

} Honorable David O. Carter

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1 Pursuant to the Court's Order dated May 1, 2012 (Doc. 52) and Rule 56  
2 of the Federal Rules of Civil Procedure, Defendant Keating Dental Arts  
3 ("Keating") respectfully moves for summary judgment on its claim for  
4 cancelation of U.S. Trademark Registration No. 3,739,663 for the mark  
5 BRUXZIR, owned by Plaintiff James R. Glidewell Dental Ceramics, Inc., d/b/a  
6 Glidewell Laboratories ("Glidewell"). Attached as Appendix A is a list of  
7 supporting declarations with associated exhibits.

8 **I. INTRODUCTION**

9 BRUXZIR is pronounced "bruxer" and is registered for use in connection  
10 with dental devices that Glidewell advertises as "ideal for bruxers," people who  
11 "brux," i.e., grind their teeth. Glidewell's video promotions and videotaped  
12 witness testimony establish that the mark BRUXZIR is pronounced the same as  
13 "bruxer." Thus, BRUXZIR is the phonetic equivalent and/or corrupted spelling of  
14 "bruxer," the intended user of Glidewell's product. The mark is therefore  
15 generic. This is further supported by the undisputed evidence establishing that  
16 the relevant consumers—dentists and dental labs—identify "bruxzir" as a generic  
17 term for bruxer crowns made of zirconia. Glidewell itself uses the term as a noun  
18 and a plural noun for zirconia crowns, which is further evidence of genericness.

19 At the very least, Glidewell's mark is merely descriptive and Glidewell  
20 has failed to prove secondary meaning in the mark, i.e. that relevant purchasers  
21 view the *primary significance* of the mark as identifying Glidewell. Glidewell  
22 admits that brux means teeth grinding and "zir" means zirconia. According to  
23 Glidewell's Marketing VP, that is precisely why Glidewell picked the mark  
24 ("because . . . if you see brux or you identify somebody with bruxism. Think of  
25 zirconium. So we put brux and zir together.")

26 Although, Glidewell's trademark registration provides *prima facie*  
27 evidence of secondary meaning, the undisputed evidence easily rebuts this  
28 presumption. Glidewell had used its mark for less than two years when Keating

1 began selling its KDZ Bruxer product and Glidewell has failed to submit any  
2 survey evidence or other evidence sufficient to establish secondary meaning in  
3 the minds of the relevant consumers.

4       Cancelation of Glidewell's registration is in the public interest. Glidewell  
5 has grossly overreached in asserting its registration against competitors who use  
6 the generic terms "brux" and "bruxer" in their product names to describe  
7 features of their products. Keating is being damaged by Glidewell's improper  
8 assertion of its invalid U.S. Trademark Registration against Keating's KDZ  
9 Bruxer mark. Accordingly, Keating respectfully requests that the Court order  
10 that Glidewell's U.S. Trademark Registration No.3,739,663 be canceled.

## 11                   **II. STATEMENT OF UNCONTROVERTED FACTS**

### 12           **A. Bruxing, Bruxism, and Bruxers**

13       The consuming public for the products at issue in this case are dentists  
14 and dental laboratories. (SOF ¶ 1.) Dentists and other dental professionals refer  
15 to the subconscious grinding of teeth as "bruxing" and the associated medical  
16 condition as "bruxism." (SOF ¶ 2.) The term "bruxism" is defined in Dorland's  
17 Illustrated Medical Dictionary (32<sup>nd</sup> Ed. 2012) as "involuntary, nonfunctional,  
18 rhythmic, or spasmodic gnashing, grinding, and clenching of teeth." (SOF ¶ 3.)  
19 The term "brux" is defined as "to grind the teeth rhythmically or  
20 spasmodically." (SOF ¶ 4.) Dentists are taught these terms during dental  
21 school, including Glidewell's in-house dentist, Dr. Michael DiTolla, and  
22 Keating's expert witness with over forty years of experience as a prosthodontist,  
23 Dr. David Eggleston. (SOF ¶ 5.)

24       Dentists and other dental professionals refer to dental patients who suffer  
25 from bruxism as "bruxers." (SOF ¶ 6.) Peer-reviewed journal articles from the  
26 dental field have for decades used "bruxer" as a generic term for people  
27 suffering from bruxism. (SOF ¶ 7.) United States patents and patent  
28 applications dating back to the 1980's use the term "bruxer" to identify people

1 suffering from bruxism. (SOF ¶ 8.)

2 **B. Dental Laboratories and Dental Restorations (“Crowns”)**

3       Crowns and bridges are dental restorations used by dentists to treat  
 4 patients with damaged or missing teeth. (SOF ¶ 9.) Dentists order crowns from  
 5 “dental laboratories” that manufacture the crowns for the dentists based on  
 6 specifications provided by the dentist. (SOF ¶ 10.) There are over 2,000 dental  
 7 laboratories in the U.S. servicing the needs of dentists. (SOF ¶ 11.)

8       Plaintiff Glidewell, founded in 1970, is by far the largest dental  
 9 laboratory in the U.S. (SOF ¶ 12.) In 2002, Shaun Keating founded Keating  
 10 Dental Arts. (SOF ¶ 13.) Prior to founding his company, Mr. Keating worked at  
 11 Glidewell for eighteen years, most of that time as a manager responsible for  
 12 over 200 employees. (SOF ¶ 14.)

13       For decades dental labs manufactured crowns made entirely or partially of  
 14 porcelain, a material that gives a tooth-like appearance. (SOF ¶ 15.) Dental  
 15 labs have also developed layered combinations of materials, to create stronger  
 16 crowns that look tooth-like, such as a porcelain-fused-to-metal (“PFM”) crown.,  
 17 (SOF ¶ 16-17.)

18       Bruxers are notorious for breaking traditional porcelain crowns due to the  
 19 excessive forces they place on their teeth. (SOF ¶ 18.) Such patients have  
 20 traditionally been provided with crowns made entirely out of metal, such as  
 21 gold, which is more durable and capable of withstanding the stresses associated  
 22 with chewing and grinding. (SOF ¶ 19-20.) To patients, gold is not  
 23 aesthetically pleasing because it does not look like a tooth and is a “last resort  
 24 for people with chewing problems.” (SOF ¶ 21-22.)

25 **C. Glidewell Develops An All-Zirconia Crown As A Replacement For**  
 26 **Gold Crowns**

27       Because many patients are very resistant to receiving gold crowns, dental  
 28 professionals have sought to develop a crown that is strong like gold but that

1 looks like a natural tooth. Glidewell's in-house dentist, Dr. DiTolla, for years  
 2 asked his R&D department "for a cast gold material that's white like a tooth so  
 3 patients will accept it." (SOF ¶ 23.) Glidewell's Director of R&D repeated Dr.  
 4 DiTolla's desire: "His [Dr. DiTolla's] saying was always, 'Why can't we make  
 5 a full gold crown that is white? Give me a white full gold crown.'" (SOF ¶ 24.)

6 Glidewell spent several years leading up to 2009 developing an all-  
 7 zirconia crown. (SOF ¶ 25.) Zirconia is an extremely strong material that  
 8 dental labs began using years earlier as a substitute for the invisible metal lower  
 9 layer in PFM crowns. (SOF ¶ 26.) Although Zirconia is white, it does not  
 10 appear "toothlike" so it is not nearly as aesthetic as porcelain. (SOF ¶ 27.)

11 Glidewell's Director of R&D recalled that its first attempt at making an  
 12 all-zirconia crown was a failure. (SOF ¶ 28.) Eventually Glidewell's R&D  
 13 efforts resulted in an all-zirconia crown that it deemed aesthetic enough, and it  
 14 decided to release the new crown as a new product. (SOF ¶ 29.)

15 **D. Glidewell Names Its All-Zirconia Crown "BruxZir"**

16 Glidewell's VP of Advertising, Jim Shuck, proposed "BruxZir" as the  
 17 name of the new all-zirconia crown. (SOF ¶ 30.) He explained that the name  
 18 was chosen to combine **bruxism** and **zirconia**: "That's why we picked the name,  
 19 because . . . if you see brux or you identify somebody with brux or bruxism,  
 20 think of zirconium. So we put brux and zir together." (SOF ¶ 31.)

21 Glidewell's in-house dentist, Dr. DiTolla, immediately liked it because it  
 22 described the functionality of the crown. (SOF ¶ 32.) Back in June 2009 he  
 23 responded to Mr. Shuck's proposed name as follows:

24 I like BruxZir for a couple of reasons . . .

25 It is catchy, clever and memorable. . . .

26 It also describes it's [sic] main indication as we see it today: an  
 27 unbreakable crown for your patients who have broken or might break  
 28 other restorations. When you want gold and the patient wants white,  
 BruxZir will make both of you happy.

No other crown has ever been marketed as the crown for bruxers, . . .

... The name BruxZir *sells the function of the crown* and not the esthetics. It doesn't try to be something that it's not. *It's a crown for bruxers....We have so many "esthetic" restorations, I would prefer to emphasize its physical advantages....*

... And, yes, what should I use on a grinder? BruxZir is a great answer.

(SOF ¶ 33 (emphasis added).)

In his deposition, Dr. DiTolla testified “[I]” I thought it was clever because of the “Zir” for zirconia”; that the dentist was going to know what was in there.” (SOF ¶ 34.)

Glidewell's Director of R&D, Mr. Friebauer, also liked the name: “[t]o me, it stands for bruxism and zirconia. It makes sense to me” . . . (SOF ¶¶35-36.) Glidewell's Sales Manager, Robin Bartolo, also liked the name: “So here you had something that looked like a tooth and yet was strong enough to withstand even patients that would brux at night or during the day. So it was a great name to convey strength.” (SOF ¶ 37.)

Glidewell admits that the mark BRUXZIR was adopted, at least in part, to connote a product that is useful for bruxers. (SOF ¶ 38.)

## E. Glidewell Markets Its All-Zirconia Crown For Use With Bruxers

In June 2009, Glidewell began offering for sale the new all-zirconia crown under the name “BruxZir.” (SOF ¶ 39.) Glidewell prominently and widely promoted the new all-zirconia crown to its customers as “ideal” for bruxer patients in the marketing materials it sent to dentists. (SOF ¶ 40.) Because the aesthetics of its new all-zirconia crown was poor compared to conventional porcelain crowns, Glidewell further marketed the crown as “More Brawn Than Beauty.” (SOF ¶¶ 41-42.)

Glidewell also promoted the use of its all-zirconia crown for bruxers in technical articles authored by its Vice President of R&D, Mr. Carden. (SOF ¶

1 43.) By way of example, an article authored by Mr. Carden states that  
 2 “[p]rimary candidates [for all-zirconia restorations] include bruxers and grinders  
 3 who do not desire cast gold or metal occlusal PFM restorations.” (SOF ¶ 44.)

4 Glidewell also promoted the use of its all-zirconia crown as “ideal for  
 5 bruxers” on its website. (SOF ¶ 45.) The web site further explains that:

6 When we launched BruxZir Solid Zirconia crowns & bridges in 2009, our  
 7 intention was to provide a monolithic zirconia restoration *indicated for*  
 8 *bruxers and grinders* as an esthetic alternative to posterior metal occlusal  
 PFM and full-cast metal restorations. The result was a material we said  
 was “More Braun than Beauty.”

9 (SOF ¶ 46.)

10 **F. The Name BruxZir Is Pronounced The Same As “Bruxer”**

11 Glidewell’s in-house dentist, Dr. DiTolla, has published many  
 12 promotional videos available on the internet (through Glidewell’s website or  
 13 iTunes) that discuss dental techniques relating to the BruxZir product. (SOF ¶  
 14 47.) In those videos, Dr. DiTolla pronounces the name BruxZir and the dental  
 15 term bruxer identically. (SOF ¶ 48.) In their videotaped depositions in this  
 16 case, Glidewell’s witnesses’ pronounced BruxZir and bruxer identically. (SOF  
 17 ¶ 49.)

18 Starting in early 2011, Glidewell sent a number of cease and desist letters  
 19 to dental laboratories who uses the word “Bruxer,” or variations thereon, in  
 20 connection with all-zirconia crowns. (SOF ¶ 50.) In those communications,  
 21 Glidewell’s General Counsel, Keith Allred, asserted to the third parties that their  
 22 names were confusingly similar to Glidewell’s mark because BruxZir and  
 23 bruxer sound the same. (SOF ¶ 51.) By way of example, on February 14, 2011,  
 24 Mr. Allred sent the following message to Pittman Dental Lab, who had been  
 25 advertising a BRUXER All Zirconia Crown: “BruxZir® / BRUXER: **sounds**  
 26 **the same doesn’t it?** And, that is what gives rise to the matter of trademark  
 27 infringement.” (SOF ¶ 52)

1 Dentists outside of Glidewell also pronounce BruxZir and bruxer  
 2 identically. (SOF ¶ 53.)

3 **G. Glidewell Uses BruxZir Generically**

4 In its promotional materials, Glidewell reinforces the use of “bruxzir” or  
 5 “bruxer” crown as nomenclature for an all zirconia crown, not as a trademark  
 6 indicating the source of the product. (SOF ¶ 54.) For example, in Glidewell’s  
 7 promotional video, Dr. DiTolla compares a “bruxzir” or “bruxer” crown to a  
 8 metal occlusal PFM [porcelain fused to metal] crown and a gold cast crown.  
 9 (SOF ¶ 55.) These are generic names for types of crowns with which dentists  
 10 are very familiar. (SOF ¶ 56.). Glidewell also uses the word BRUXZIR as a  
 11 noun and plural noun, which is further evidence of generic use. (SOF ¶ 57.) Dr.  
 12 DiTolla, states in Glidewell’s promotional videos that one could even get “a  
 13 couple of BruxZirs put in.” (SOF ¶¶ 58.) In continuing education lectures,  
 14 given to dentists around the country, Dr. DiTolla uses the terms “BruxZir  
 15 crown” and “full-contour zirconia” interchangeably for educational purposes.  
 16 He states, “I want to drive it into them and make sure they walk away knowing  
 17 that it’s a solid zirconia crown.” (SOF ¶ 59.)

18 **H. The Widespread Use of “Brux” and “Zir” In The Dental Industry**

19 In addition to Glidewell and Keating, many other companies have been  
 20 using “Brux” to refer to dental products for use with bruxers and “Z” or “Zir” to  
 21 refer to dental products associated with zirconia. Examples include, Arthtek  
 22 Bruxing Splint, GPS BruxArt, Brux XXX, BruxCure, BruxChecker, Brux-eze,  
 23 BruxCare, Bruxguard, Dr. Brux, ZerisBRUX, ZirCAD (zirconia blocks),  
 24 ZirColor (coloring product for zirconia), ZirPress (for ceramic ingots), ZirLiner  
 25 (zirconia bonding material), Zir-Cut (zirconia polisher), ZirBlock (dental  
 26 products), Zirprime (pre-sintered zirconia), Zir-Cut (burs for cutting Zr), Zir-Cut  
 27 Diamond FG (specialty burs), Zir.Care (multipurpose stone), ZiReal (Zr dental  
 28 posts) (SOF ¶ 60.)

1     **I. All-Zirconia Crowns Offered By Other Dental Laboratories**

2           In addition to Glidewell and Keating, many other dental laboratories have  
3           been offering all-zirconia crowns under a variety of names, including names  
4           with “Brux,” “Zir,” or variations thereon. Examples include:

- 5           • \* Advanced Dental Lab — BruxZir
- 6           • \* Assured Dental Lab — Z-Brux
- 7           • \* Authentic Dental Lab — Brux
- 8           • \* Barth Dental Lab — Z-Brux
- 9           • Burbank Dental — Zir-Max
- 10           • California Dental Arts — ZirFit
- 11           • \* China Dental Outsourcing — Bruxer All Zirconia
- 12           • \* China Dental Outsourcing — All Zirconia for Bruxers
- 13           • Continental Dental — Full Zirconia for Bruxing Patients
- 14           • Cosmetic Dentistry of SA — Bruxer Crown
- 15           • Dani Dental — Full Zirconia (Bruxer)
- 16           • Diadem Precision Technology — Diazir
- 17           • Distinctive Dental — Zir-Tech
- 18           • Drake Dental — Zir-Cast
- 19           • Expertec — Full-Z
- 20           • \* Fusion Dental Lab — Full Solid Bruxer Zirconia
- 21           • GPS Dental Lab — GPS BruxArt
- 22           • Kastle Mills — ZirCrown
- 23           • Mascola Esthetics — Xtreme Bruxer
- 24           • \* Old Dominion Milling Corp. — Bruxzer
- 25           • \* Pittman Dental — ZirCAM
- 26           • \* Pittman Dental — Bruxer All-Zirconia Crown
- 27           • \* R-dent Dental Laboratory — R-Brux
- 28           • \* Showcase Dental Lab — Zir-Bruxer

- 1      • Somer Dental Labs — Full Contour Zir
- 2      • Summers Dental Lab — BruxThetix
- 3      • Sun Dental Labs — Suntech Full Zirconia
- 4      • Technics Dental Lab — Tech/ZIR FC
- 5      • Trachsel Dental — All Zirconia Bruxer
- 6      • York Dental Lab — Bruxer
- 7      • Zahn Dental — Zirlux

8 (SOF ¶ 61.)

9      Many dental laboratories prominently promote their all-zirconia crowns  
10     for use by bruxers. (SOF ¶ 62.) Examples include:

- 11     • Barth Dental Labs — “ideal for bruxers”
- 12     • California Dental Arts — “Perfect for bruxers”
- 13     • China Dental Outsourcing — “primarily for bruxers and heavy biters”
- 14     • Drake Dental — “Recommended for Bruxers and Grinders”
- 15     • Expertec — “ideal for patients who brux”
- 16     • Infinity Dental Lab — “Bruxer Crowns”
- 17     • Sun Dental Labs — for “bruxers and grinders”
- 18     • York Dental Lab — “ideal restoration for bruxers”

19 (SOF ¶ 62.)

20     As noted above, Glidewell has sought to stop all other dental labs from  
21     using the word “Bruxer,” or variations thereof, in the name of their all-zirconia  
22     crowns. The dental labs in the list above marked with an asterisk received  
23     cease-and-desist letters from Glidewell and subsequently stopped using the  
24     name. (SOF ¶ 63.)

25 **J. Glidewell’s 180 “Authorized” Labs Sell “BruxZir” Crowns, Most of**  
26 **Which Do Not Identify Glidewell As A Source Or Affiliated Entity**

27     Glidewell makes zirconia “blanks” (the raw material from which zirconia  
28     crowns may be made) that it sells to about 180 “authorized” dental laboratories

1 around the U.S. for use by those laboratories in making their own all-zirconia  
 2 crowns. (SOF ¶ 64.) The “authorized” laboratories make and sell crowns using  
 3 the BruxZir name, just like Glidewell does. (SOF ¶ 65.) Most of the  
 4 “authorized” laboratories have web sites promoting their “BruxZir” crowns,  
 5 often with the same language used in Glidewell’s marketing materials. (SOF ¶  
 6 66.) The vast majority of these laboratories do not identify Glidewell as an  
 7 affiliated entity. (SOF ¶ 67.) Instead, they typically promote the BruxZir crown  
 8 as their own crown coming from their own dental laboratory. (SOF ¶ 67.)  
 9 Glidewell makes no effort to monitor the use of the BruxZir mark by its  
 10 authorized labs, and it does not require those labs to identify Glidewell as an  
 11 affiliated entity. (SOF ¶ 68.) This practice reinforces the understanding among  
 12 dentists that “BruxZir” is a product available from multiple sources, not an  
 13 indicator of a single source or producer. (SOF ¶ 69.)

14 **K. Dentists Use The Term BruxZir Generically**

15 In May 2011, Keating Dental Arts began offering for sale an all-zirconia  
 16 crown called the “KDZ Bruxer.” (SOF ¶ 70.) Over the following year Keating  
 17 fulfilled over 5,000 prescription forms by supplying its dentist customers with  
 18 the KDZ Bruxer product. (SOF ¶ 71.) Over that span, dentists (or their  
 19 assistants) wrote the word “bruxzir,” “bruxzer,” or variations thereof, on about  
 20 fifty of the prescription forms requesting all-zirconia crowns. (SOF ¶ 72.) This  
 21 corresponds to approximately 1% of the Keating prescription forms over that  
 22 time period. (SOF ¶ 73.)

23 When receiving prescription forms with such misspellings, it was  
 24 Keating’s policy to call the dentist and confirm that they wanted Keating’s all-  
 25 zirconia crown, and not the crown from any other laboratory. (SOF ¶ 74.) In  
 26 these instances, the dentist always confirmed that they wanted Keating’s KDZ  
 27 Bruxer all-zirconia crown. (SOF ¶ 75.)

28 / / /

1       Many dentists in the industry refer to all-zirconia crowns as a “BruxZir,”  
 2 “bruxzir,” or variations thereon. (SOF ¶ 76.) Dentists who submitted  
 3 prescription forms to Keating with such spellings wrote that word as a generic  
 4 reference to an all-zirconia crown, not to identify Glidewell Laboratories as a  
 5 source. Keating is submitting thirteen declarations from dentists who submitted  
 6 prescription forms to Keating with “bruxzir” or “BruxZir” written on them to  
 7 explain this point. (SOF ¶ 77.)

8       Showcase Dental Laboratory, a dental lab unaffiliated with Glidewell or  
 9 Keating, has also received prescription forms from dentists ordering all-zirconia  
 10 crowns that generically describe an all-zirconia crown as a “BruxZir,”  
 11 “bruxzir,” or variation, thereof. (SOF ¶ 78.)

12 **L. Keating Adopted Its KDZ Bruxer Mark In Good Faith**

13       Based on the perceived demand for all-zirconia crowns of its dentists,  
 14 Keating decided to formally add an all-zirconia crown to its KDZ line of products  
 15 (which had been introduced in 2006). (SOF ¶ 79.) Because the new all-zirconia  
 16 crown was specifically designed to replace gold crowns for bruxer patients, Mr.  
 17 Keating wanted to call the new crown the “KDZ Bruxer.” (SOF ¶ 80.)

18       Mr. Keating sought the advice of counsel, who performed a trademark  
 19 search, to ensure his use of the name would not cause problems. (SOF ¶ 82.)

20 **M. Glidewell Has Presented No Credible Actual Confusion Evidence**

21       In its responses to Keating’s interrogatories, Glidewell alleged details for  
 22 two instances of alleged actual confusion:

23       (1) In April 2012, a Glidewell employee named Nicole Fallon offered a  
 24 \$20 coupon to Dr. Jade Le’s dental office in Florida to try a BruxZir restoration.  
 25 An employee in Dr. Le’s office asked if she could apply the coupon to a  
 26 previous purchase the office had made of Keating’s KDZ Bruxer crown. (SOF  
 27 ¶ 83.). Glidewell explained that Ms. Fallon made a telephone call to Dr. Le’s  
 28 office and offered a discount on BruxZir crowns. (SOF ¶ 84.)

4 Glidewell employees, and dental professionals generally, pronounce  
5 BruxZir and Bruxer identically. (SOF ¶ 85.) The only “confusion” apparent  
6 from the record associated with Ms. Fallon’s phone call resulted from Ms.  
7 Fallon’s failure to unambiguously identify the product associated with her  
8 coupon offer. Likewise, Glidewell’s identification of Dr. Nussear’s prescription  
9 form is not evidence of actual confusion. (SOF ¶ 86.) Keating is submitting a  
10 declaration from Dr. Nussear in which he explains that he wrote “BruxZir” on  
11 his prescription form as a generic reference to an all-zirconia crown. (SOF ¶  
12 87.) Dr. Nussear further explains that he did not intend to order a crown from  
13 Glidewell, and he was not confused as to any affiliation between Keating and  
14 Glidewell. (SOF ¶ 87.)

15 N. **The Trademark Office Did Not Fully Examine Glidewell's**  
16 **Trademark Application For BRUXZIR**

17 Glidewell filed to federally register a trademark in the mark BRUXZIR  
18 for use in connection with “dental bridges; dental caps; dental crowns; dental  
19 inlays; dental onlays; dental prostheses” on June 17, 2009. (SOF ¶ 88.) On  
20 January 19, 2010, Glidewell’s application issued as Trademark Registration No.  
21 3,739,663. (SOF ¶ 89.)

22 During the examination process, the Trademark Examiner did not conduct  
23 an Internet search and made no inquiry as to whether BRUXZIR had any  
24 meaning in the dental industry. (SOF ¶ 90.) The Examiner should have  
25 performed a search of the Internet for “crowns designed for bruxers.” (SOF ¶  
26 91.) Had the Examiner learned that Glidewell pronounces BRUXZIR the same  
27 as “bruxer,” and promotes the same pronunciation in its marketing materials for  
28 ///

1 the BruxZir product, the mark would have been denied registration as either  
 2 generic or merely descriptive. (SOF ¶ 92.)

3       Trademark Examiners are obligated to follow the Trademark Manual of  
 4 Examining Procedure (TMEP) when examining applications. (SOF ¶ 93.) In  
 5 examining Glidewell's application for BRUXZIR, the Examiner should have  
 6 asked if the mark had any particular meaning in relation to the goods or in the  
 7 relevant trade or industry and should have requested additional information  
 8 about the mark and the goods. (SOF ¶ 94.) In this case, the examining attorney  
 9 did not make any such requests during Glidewell's trademark application (SOF  
 10 ¶ 95.) Nor did Glidewell offer any such information (SOF ¶ 96.)

### **III. SUMMARY JUDGMENT STANDARDS**

12       Summary judgment is appropriate when "there is no genuine issue as to  
 13 any material fact and the moving party is entitled to judgment as a matter of  
 14 law." Fed. R. Civ. P. 56(c). As the moving party, Keating has the burden of  
 15 establishing the lack of a genuine issue of material facts. *Celotex Corp. v.*  
 16 *Catrett*, 477 U.S. 317, 322-323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). A  
 17 genuine issue of material fact exists only where "there is sufficient evidence  
 18 favoring the nonmoving party for a jury to return a verdict for that party."  
 19 *Anderson v. Liberty Lobby, Inc.* 477 U.S. 242, 249, 106 S. Ct. 2505, 91 L. Ed.  
 20 2d 202 (1986). In other words, any dispute as to material facts must be genuine  
 21 and not merely a theoretical possibility. *Matsushita Elec. Indus. Co. v. Zenith*  
 22 *Radio Corp.*, 475 U.S. 574, 586 106 S. Ct. 1348, 1356 89 L. Ed. 2d 538, 552  
 23 (1986). The moving party bears the initial burden of demonstrating the absence  
 24 of a genuine issue of material fact for trial, but it need not disprove the other  
 25 party's case. *Celotex*, 477 U.S. at 323-25. A dispute cannot be "genuine" unless  
 26 it is supported by evidence sufficient to permit a reasonable jury to find in favor  
 27 of the nonmoving party. *Anderson*, 477 U.S. at 247-48.

28       Because BRUXZIR is a registered trademark, "a presumption of validity

1 places the burden of proving genericness upon" Keating. *Advertise.com, Inc. v.*  
 2 *AOL Advertising, Inc.*, 616 F.2d 974, 977 (9th Cir. Cal. 2010) (citing *Filipino*  
 3 *Yellow Pages, Inc. v. Asian journal Publs. Inc.*, 198 F.3d 1143, 1146 (9th Cir.  
 4 1999). 15 U.S.C. § 1057(b). Keating may rebut this presumption by a  
 5 preponderance of the evidence showing the mark is generic or lacks secondary  
 6 meaning. *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419  
 7 F.3d 925, 928 (9th Cir. 2005), *Surgicenters of America, Inc. v. Medical Dental*  
 8 *Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979). "The crucial date for the  
 9 determination of genericness is the date on which the alleged infringer entered  
 10 the market with the disputed mark or term. *Yellow Cab*, 419 F.3d at 928.

11 The evidence is more than sufficient to rebut the presumption of validity  
 12 of Glidewell's BRUXZIR registration.

13 **IV. BRUXZIR IS GENERIC AND/OR COMMONLY DESCRIPTIVE**  
 14 **AND IS NOT ENTITLED TO TRADEMARK PROTECTION**

15 15 U.S.C. § 1127 defines a trademark "as including 'any word, name,  
 16 symbol, or device or any combination thereof' used by any person 'to identify  
 17 and distinguish his or her goods, including a unique product, from those  
 18 manufactured or sold by others and to indicate the source of the goods, even if  
 19 that source is unknown.'" *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763,  
 20 768 (1992) (quoting 15 U.S.C. § 1127).

21 In determining whether a mark is entitled to trademark protection, the  
 22 courts recognize four categories of terms: 1) generic; 2) descriptive; 3)  
 23 suggestive; and 4) arbitrary or fanciful. *Rudolph Int'l, Inc. v. Realys, Inc.*, 482  
 24 F.3d 1195, 1196-98 (9th Cir. 2007) (affirming summary judgment of  
 25 genericness), citing *Filipino Yellow Pages*, 198 F.3d at 1146.

26 A generic term, also known as a common descriptive term, refers to the  
 27 type or species of the product at issue. Generic terms cannot be protected  
 28 trademarks. Descriptive terms "generally do not enjoy trademark

1 protection” but may be protected if they acquire ‘secondary meaning’ in  
 2 the minds of consumers, i.e., [they] become distinctive of the trademark  
 3 applicant’s goods in commerce.

4 *Rudolph*, at 1197-98 (internal citations omitted). See also *Advertise.com* 616  
 5 F.3d at 977 (finding registered mark generic). “To allow trademark protection  
 6 for generic terms . . . even when [they] have become identified with a first user,  
 7 would grant the owner of the mark a monopoly, since a competitor could not  
 8 describe his goods as what they are.” *Surgicenters*, 601 F.2d at 107.

9 **A. Glidewell’s BRUXZIR mark identifies the product, not the producer**

10 The determination of whether a mark is generic depends on how the  
 11 consuming public understands the meaning of the term. *Yellow Cab*, 419 F.3d at  
 12 929 (“To determine whether a term has become generic, we look to whether  
 13 consumers understand the word to refer only to a particular producer’s goods or  
 14 whether the consumer understands the word to refer to the goods themselves.”  
 15 (quoting *KP Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d  
 16 596, 604 (9th Cir. 2005)); see also *Rudolph*, 482 F.3d at 1198; *Filipino Yellow*  
 17 *Pages*, 198 F.3d at 1148; *Surgicenters*, 601 F.2d at 1015 n.11; *Van Well*  
 18 *Nursery, Inc. v. Mony Life Ins. Co.*, 421 F. Supp. 2d 1321, 1327-28 (E.D. Wash.  
 19 2006) (“Even the most distinctive symbols – coined words having no  
 20 descriptive or suggestive quality – may become generic if they are adopted by  
 21 the public as the name of the product rather than as the mark of the producer.”)  
 22 See also *In re Reckitt & Colman, North America Inc.*, 18 U.S.P.Q. 2d (BNA)  
 23 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use  
 24 on permanent press products). The test is whether the relevant public would  
 25 understand the term to be generic. See *In re 1800Mattress.com IP, LLC*, 586  
 26 F.3d 1359, 92 U.S.P.Q. 2d (BNA) 1682, 1685 (Fed. Cir. 2009). As the Ninth  
 27 Circuit stated in *Rudolph*:

28 “The question of genericness is often answered by reference to the “who-

1                   “are-you/what-are-you” test: a valid trademark answers the former  
 2                   question, whereas a generic product name or adjective answers the latter.”  
 3 *Rudolph*, 482 F.3d at 1198, citing *Filipino Yellow Pages*, 198 F.3d at 1147 (“[I]f  
 4                   the primary significance of the trademark is to describe the *type of product*  
 5                   rather than the *producer*, the trademark [is] a generic term and [cannot] be a  
 6                   valid trademark.”) (emphasis in original); *CG Roxane LLC v. Fiji Water Co.*  
 7 *LLC*, 569 F. Supp. 2d 1019, 1026 (N.D. Cal. 2008) (granting defendant’s  
 8                   motion for summary judgment holding that defendant had provided sufficient  
 9                   evidence to overcome the presumption of trademark validity, prove genericness  
 10                   and a lack of secondary meaning).

11                   Glidewell admits that relevant consumers--dentists and dental labs--  
 12                   understand the term “brux” to describe patients who brux, and/or as a derivation  
 13                   of “bruxing,” and that the term “zir” is understood by dentists as meaning  
 14                   zirconia. Glidewell admits that the term “bruxer” is generic for people who  
 15                   suffer from bruxism.

16                   The undisputed evidence, including Glidewell’s videorecorded witness  
 17                   testimony and promotional videos, establishes that the term “bruxzir” is  
 18                   phonetically equivalent to “bruxer.” The undisputed evidence establishes that  
 19                   the terms “bruxer” and “bruxzir” are widely used and understood by dentists to  
 20                   denote bruxer crowns and/or bruxer crowns made of zirconia.

21                   The term “bruxzir” does not serve to identify a particular source of  
 22                   crown, but only the type of crown. This is further supported by Glidewell’s own  
 23                   promotional videos, in which Glidewell uses the term BruxZir (sounding  
 24                   identical to “bruxer”) as a noun for its all-zirconia crowns. In its videos,  
 25                   Glidewell even states that one could get “a couple of BruxZirs put in.” Such use  
 26                   is evidence of genericness. In addition, it is inevitable that dentists will call a  
 27                   crown for bruxers “a bruxer crown” or a “bruxzir crown.” See *In re Vanilla*  
 28 *Gorilla, L.P.*, 80 U.S.P.Q. 2d 1637, 1640 (TTAB 2006) (“[T]he users of

1 language have a universal habit of shortening full names . . . I regard it as  
 2 inevitable that a gas monitoring badge will be called a gas badge.”) (quoting *In*  
 3 *re Abcor Development Corp. v.* , 588 F.2d 811, 200 U.S.P.Q. (BNA) 215, 219  
 4 (CCPA 1978) (Rich, J. concurring).

5 In addition, many of the labs that Glidewell has authorized to make and  
 6 sell crowns made from its BruxZir material do not identify Glidewell as the  
 7 source. Instead, they often advertise as Glidewell’s competitors. This evidence  
 8 reinforces the understanding among dentists that “BruxZir” is a product, not a  
 9 producer.

10 Because the evidence establishes that dentists and dental labs use and  
 11 understand the term BruxZir as a generic term to identify a crown for bruxers,  
 12 not to identify Glidewell, it is not entitled to registration as a trademark because  
 13 it primarily denotes the product, not the producer.

14 **B. Glidewell’s BRUXZIR Mark Should Be Canceled Because It Is**  
 15 **Phonetically Equivalent To And A Misspelling Of Bruxer**

16 Courts have long held that the corrupted spelling or phonetic equivalent  
 17 of a generic term is also generic. *See, e.g., Soweco, Inc. v. Shell Oil Co.*, 617  
 18 F.2d 1178, 1186 n.24 (5th Cir. 1980) (“Plaintiff’s using the phonetic equivalent  
 19 of the generic term ‘larvicide’ in its mark ‘Larvacide,’ i.e., misspelling it, does  
 20 not render the mark protectable.” (citing *Miller Brewing Co. v. G. Heileman*  
 21 *Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977)) (“Using the phonetic equivalent  
 22 of a common descriptive word, i.e., misspelling it, is of no avail.”); *Am. Aloe*  
 23 *Corp. v. Aloe Creme Labs., Inc.*, 420 F.2d 1248, 1253 (7th Cir. 1970) (“By  
 24 using the phonetic equivalent of the generic name as the sole common and  
 25 distinguishing mark of its products, defendant invited confusion.”); *see*  
 26 *McCARTHY ON TRADEMARKS*, 4TH EDITION, § 12:38; *Rudolph*, 482 F.3d at 1198  
 27 (citing to *Nupla Corp. v. IXL Mfg. Co.*, 114 F.3d 191, 196 (Fed. Cir. 1997)  
 28 (affirming summary judgment holding that plaintiff’s registered mark CUSH-N-

1 GRIP is invalid as a generic misspelling of “cushion grip” for cushioned tool  
 2 handles); *Brookfield Commc'n v. West Coast Entmt. Corp.*, 174 F.3d 1036,  
 3 1058 fn. 19 (9th Cir. 1999) (citing to *Miller Brewing Co.*, 561 F.2d at 81 (“Lite  
 4 Beer” phonetic equivalent to generic “light beer”; *C-Thru Ruler Co. v.  
 5 Needleman*, 190 U.S.P.Q. 93 (E.D. Pa. 1976) (C-THRU held equivalent of “see-  
 6 through” and, therefore, merely descriptive of transparent rulers and drafting  
 7 aids); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-  
 8 LYX held generic for mineral licks for feeding livestock).

9 If a mark bears a misspelling and is phonetically identical to an otherwise  
 10 descriptive or generic term, it is considered a “legal equivalent” and should be  
 11 treated the same as would the ordinary spelling. *In Re State Chemical Mfg.  
 12 Co.*, 225 U.S.P.Q. (BNA) 687 (TTAB 1985) (FOM held to be legal equivalent  
 13 of “foam”; referencing prior “legal equivalents” cases, namely, TINTZ for tints,  
 14 ALKOL for alcohol, LITE for light, SAVON GAS for “save on gas”); see also  
 15 *In re Vanilla Gorilla*, 80 U.S.P.Q. 2d at 1640 (“3-O’s” merely descriptive of car  
 16 wheel rims)

17 The “intended user” can also be the basis for refusal of registration on the  
 18 grounds of genericness. In *In re Mortgage Bankers Association of America*, 226  
 19 U.S.P.Q. (BNA) 954 (TTAB 1985), the TTAB upheld refusal of registration of  
 20 the mark CERTIFIED MORTGAGE BANKER for “educational services,  
 21 namely providing qualifying examinations, testing and grading in the field of  
 22 real estate finance,” holding the mark so highly descriptive as to be incapable of  
 23 functioning as a mark. Similarly, in *In re Reed Elsevier Props. Inc.*, 482 F.3d  
 24 1376 (Fed. Cir. 2007), the Federal Circuit affirmed the TTAB’s refusal of  
 25 registration of LAWYERS.COM on the grounds that it was generic for  
 26 “providing an online interactive database featuring information exchange in the  
 27 fields of law, legal news and legal services.”

28 Glidewell admits its BruxZir crown is a “crown for bruxers” and is “ideal

1 for bruxers.” BruxZir is pronounced identically to “bruxer” and is a corrupted  
 2 spelling of the product’s intended user—a bruxer. Accordingly, Glidewell’s  
 3 trademark is generic and should be canceled.

4 **C. Alternatively, Glidewell’s BRUXZIR Mark Is Merely Descriptive**  
 5 **And Has Not Acquired Secondary Meaning**

6 **1. Glidewell’s BRUXZIR Mark Merely Describes The Intended**  
 7 **User And Characteristics of The Product**

8 At the very least, Glidewell’s BRUXZIR Mark is merely descriptive  
 9 because, as Glidewell admits, it identifies the intended user of the product—a  
 10 bruxer. A term that identifies a group to whom the applicant directs its goods or  
 11 services is, if not generic, at least merely descriptive. See *In re Planalytics, Inc.*,  
 12 70 U.S.P.Q. 2d (BNA) 1453 (TTAB 2004) (GASBUYER merely descriptive of  
 13 risk management services in the field of pricing and purchasing natural gas);  
 14 *Hunter Publ’g Co. v. Caulfield Publ’g Ltd.*, 1 U.S.P.Q. 2d (BNA) 1996 (TTAB  
 15 1986) (SYSTEMS USER found merely descriptive of a trade journal directed  
 16 toward users of large data processing systems; evidence; *In re Camel Mfg. Co.*,  
 17 Inc., 222 U.S.P.Q. (BNA) 1031 (TTAB 1984) (MOUNTAIN CAMPER held  
 18 merely descriptive of retail mail-order services in the field of outdoor equipment  
 19 and apparel). Trademark Manual of Examining Procedure (TMEP), §  
 20 1209.03(i).

21 Rather than immediately conveying a brand or product source, merely  
 22 descriptive marks “immediately convey [] knowledge of a quality, feature,  
 23 function or characteristic of the goods or services with which [they are] used.”  
 24 *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007) (emphasis  
 25 omitted). To be determined merely descriptive and not entitled to registration, it  
 26 is sufficient to find that the mark “immediately conveys information about one  
 27 feature or characteristic of at least one of the designated” goods or services  
 28 within the applicant’s trademark applications. *In re The Chamber of Commerce*

1 *of the United States*, 675 F.3d 1297, 1298-1301 (Fed. Cir. 2012) (affirming  
 2 TTAB decision that the term “National Chamber” was merely descriptive);  
 3 *Advertise.com*, 616 F.3d at 982; *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*,  
 4 287 F.3d 866 (9th Cir. 2002). Simply combining two descriptive words  
 5 does not make a mark registrable. *Surgicenters*, 601 F.2d at 1011, citing  
 6 *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 528, 44 S.Ct. 615, 68  
 7 L.Ed. 1161 (1924) (“The name “Coco-Quinine” is descriptive of the ingredients  
 8 which enter into the preparation. The same is equally true of the name “Quin-  
 9 Coco. A name which is merely descriptive of the ingredients, qualities or  
 10 characteristics of an article of trade cannot be appropriated as a trademark and  
 11 the exclusive use of it afforded legal protection.”)

12 In addition to describing the intended user of the product--a bruxer--the  
 13 undisputed evidence establishes that dentists and dental labs understand the term  
 14 BRUXZIR to denote or at least describe full zirconia crown products that are  
 15 ideal for bruxers. Glidewell’s witnesses testified to such descriptive attributes of  
 16 the “brux” and “zir” elements of the mark. Thus, the evidence establishes that  
 17 the mark BruxZir is merely descriptive.

18 **2. Glidewell Has Failed To Submit Sufficient Evidence of**  
 19 **Secondary Meaning To Establish A Protectable Trademark**

20 “When used to describe a product, [merely descriptive marks] do not  
 21 inherently identify a particular source, and hence cannot be protected,” unless  
 22 they have acquired “distinctiveness which will allow them to be protected under  
 23 the [Lanham] Act.” *Two Pesos, Inc.*, 505 U.S. at 769. “This acquired  
 24 distinctiveness is generally called secondary meaning.” *Id.* (internal quotation  
 25 marks omitted).

26 “To establish secondary meaning, a manufacturer must show that, in the  
 27 minds of the public, the primary significance of a product feature or term is to  
 28 identify the source of the product rather than the product itself.” *Two Pesos*,

1 *Inc.*, 505 U.S. at 766 (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844  
 2 (1982)).

3 The Ninth Circuit has enunciated a four-element test the finder of fact  
 4 may consider to determine whether a mark has obtained secondary meaning,  
 5 including: “(1) whether actual purchasers of the product bearing the claimed  
 6 trademark associate the trademark with the producer, (2) the degree and manner  
 7 of advertising under the claimed trademark, (3) the length and manner of use of  
 8 the claimed trademark, and (4) whether use of the claimed trademark has been  
 9 exclusive.” *Yellow Cab*, 419 F.3d at 930 (citing *Levi Strauss & Co. v. Blue Bell*,  
 10 *Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985) (en banc)). In addition, the Ninth  
 11 Circuit has considered “direct consumer testimony; survey evidence;  
 12 exclusivity, manner, and length of use of a mark; amount and manner of  
 13 advertising; amount of sales and the number of customers; established place in  
 14 the market; and proof of intentional copying by the defendant.” *Art Attacks Ink, LLC v. MGA Entm't Inc.*, 581 F.3d 1138 (9th Cir. 2009) (citing *Filipino Yellow Pages*, 198 F.3d at 1151).

17 Finally, proof of secondary meaning entails rigorous evidentiary  
 18 requirements. *Express, LLC v. Forever 21, Inc.*, 2010 U.S. Dist. LEXIS 91705  
 19 (C.D. Cal. 2010) (holding that express had failed to meet the burden necessary  
 20 for secondary meaning and granting summary judgment to Forever 21); *Seed*  
 21 *Lighting Design Co. v. Home Depot*, 2005 U.S. Dist. LEXIS 44741 (N.D. Cal.  
 22 Aug. 3, 2005);

23 Here, the evidence submitted by Glidewell in support of the existence of  
 24 secondary meaning is painfully lacking.

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1                   **3. Actual Purchasers Of Products Bearing “BRUXZIR” Mark Do**  
 2                   **Not Associate The Mark With Glidewell**

3                   Because the chief inquiry is the attitude of the consumer “[a]n expert  
 4 survey of purchasers can provide the most persuasive evidence of secondary  
 5 meaning. *Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d  
 6 1107, 1117 (N.D. Cal. 2010) (citing *Vision Sports, Inc. v. Melville Corp.*, 888  
 7 F.2d 609, 615 (9th Cir. 1989)). This is simply a reflection that secondary  
 8 meaning is, at its heart, an association in the mind of the consumer. For this  
 9 reason, “courts generally credit customer surveys as the strongest evidence of  
 10 secondary meaning.” *Aurora World, Inc. v. TY Inc.*, 719 F. Supp. 2d 1115, 1151  
 11 (C.D. Cal. 2009) (citing *Levi Strauss*, 778 F.2d at 1358 (en banc)).

12                  Glidewell has failed to submit any survey evidence or other evidence  
 13 showing an association of its BruxZir mark in the minds of the relevant  
 14 consumers.

15                  Therefore, this factor weighs against a finding of secondary meaning.

16                   **4. Glidewell Failed To Show Effectiveness of Its Advertising**

17                  Advertising, standing alone, does not establish secondary meaning. “The  
 18 ‘true test of secondary meaning’ is the effectiveness of the advertising effort.”  
 19 *Art Attacks*, 581 F.3d at 1146 (citing *Int’l Jensen v. Metrosound U.S.A.*, 4 F.3d  
 20 819, 824 (9th Cir. 1993)) (affirming summary judgment for alleged infringer).  
 21 “Naturally, a ‘large expenditure of money does not in itself create legally  
 22 protectable rights.’” *CG Roxane*, 569 F. Supp. 2d at 1031 (citing *Carter-  
 23 Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 800 (9th Cir. 1970)).

24                  Glidewell may allege that it spent millions on advertising the  
 25 “BRUXZIR” mark. But Glidewell has failed to delineate the amount spent prior  
 26 to Keating’s first use of its allegedly infringing mark. Even assuming, however,  
 27 that the entire amount was spent prior to Keating’s first use of its mark,  
 28                  ///

1 Glidewell has failed to submit any evidence that its advertising was effective in  
 2 establishing secondary meaning in the minds of the relevant consumers.

3 Therefore, this factor weighs against a finding of secondary meaning.

4 **5. Glidewell Used “BRUXZIR” For Less Than Two Years And**  
 5 **Encouraged Third Party Use**

6 Being first to market with a product does not render the product’s name  
 7 distinctive. *See In re Phoseon Tech. Inc.*, 103 U.S.P.Q. 2d (BNA) 1822 (TTAB  
 8 2012). Secondary meaning must be established through evidence existing at the  
 9 time the alleged infringer began using the allegedly infringing mark. *Sand Hill*  
 10 *Advisors*, 680 F. Supp. 2d at 1117 (citing *Levi Strauss & Co.*, 778 F.2d at 1358).  
 11 “Consequently, only evidence showing use of the mark . . . prior to Defendant’s  
 12 [allegedly infringing] use of the mark is probative of secondary meaning.” *Id.*

13 At the time Keating publicly announced its KDZ Bruxer product in  
 14 March 2011, Glidewell has used the BRUXZIR mark for less than two years.  
 15 Thus, Glidewell’s use is certainly less than the “substantial period” of  
 16 substantially exclusive use necessary to establish secondary meaning. *Art*  
 17 *Attacks*, 581 F.3d at 1145. Moreover, In this very short time, numerous third  
 18 parties were already using the terms “brux,” “zir”, “bruxer” and “bruxzir” in  
 19 connection with full zirconia crowns. This short period, coupled with the  
 20 evidence of non-exclusive use, renders it further unlikely that Glidewell  
 21 developed any appreciable secondary meaning. *Kellogg Co. v. Nat’l Biscuit Co.*,  
 22 305 U.S. 111, 119, 59 S. Ct. 109 (1938); *Art Attacks*, 581 F.3d at 1146.

23 **6. Glidewell’s Use Of BruxZir/Bruxer Has Not Been Exclusive**

24 Length of use and exclusivity are closely tied: without exclusivity it is  
 25 unlikely that a mark is associated with a single source and without time  
 26 consumers may not associate a mark with a single source. *Art Attacks*, 581 F.3d  
 27 at 1146 (holding a lack of secondary meaning despite five years of use because  
 28 plaintiff failed to establish exclusivity).

1        The evidence establishes that several third parties have used the terms  
 2        “bruxer” and “bruxzir” in connection with full zirconia crowns. The evidence  
 3        also establishes that, at the time Keating entered the market with its KDZ  
 4        Bruxer mark, Glidewell had used “BruxZir” for less than two years. Even in that  
 5        short time, Glidewell has failed to establish exclusive use. In addition, the  
 6        evidence of widespread generic and descriptive use of the phonetically  
 7        equivalent term “bruxer” further undermines Glidewell’s claim to secondary  
 8        meaning.

9        **7. Glidewell's Sales Figures Do Not Establish Secondary Meaning**

10       Evidence of product success in the marketplace does not necessarily  
 11       establish secondary meaning because such success may be easily attributable to  
 12       the desirability of the product configuration rather than the source-designating  
 13       capacity of the mark. *See Cont'l Lab. Prods. v. Medax Int'l*, 114 F. Supp. 2d  
 14       992, 1002 (S.D. Cal. 2000). “[S]ales figures alone are inadequate to establish a  
 15       connection between the product and its source.” *Id.* at 1002 (citing *Seabrook*  
 16       *Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1345 (C.C.P.A. 1977)).

17       Glidewell has produced no evidence that would establish a correlation  
 18       between Glidewell’s sales figures and the attainment of secondary meaning in  
 19       the BRUXZIR mark in the minds of the relevant consumer.

20       **8. Other Undisputed Evidence Shows No Secondary Meaning**

21       Other factors also favor Keating. The undisputed evidence establishes  
 22       that Keating adopted its KDZ Bruxer mark in good faith and Glidewell has  
 23       failed to submit any credible evidence of confusion as to source.

24       **D. Cancelation of the BRUXZIR Registration Is In Line With**  
 25       **Trademark Public Policy**

26       Glidewell’s trademark application for the mark BRUXZIR did not receive  
 27       a full examination. *See In re Noble Co.*, 225 U.S.P.Q. (BNA) 749, 750 (TTAB  
 28       1985) (“The examining attorney may request that the applicant submit

1 additional explanation or materials to clarify the meaning of the mark or the  
2 nature of the goods or services.”) Had the Trademark Examiner followed the  
3 normal examination procedure and conducted an Internet search for the term,  
4 reviewed Glidewell’s videos showing the mark was pronounced the same as the  
5 generic term “bruxer,” or asked the applicant if the mark had any meaning in the  
6 industry, the mark would have been rejected as generic or descriptive.

7 When a generic term is enforced as a mark, the public is harmed and the  
8 purposes of trademarks are subverted. *Kellogg Co.*, 305 U.S. at 122, (“Sharing  
9 in the goodwill of an article unprotected by patent or trade-mark is the exercise  
10 of a right possessed by all – and in the free exercise of which the consuming  
11 public is deeply interested.”). Giving Glidewell exclusive rights to the term  
12 BruxZir is inappropriate because Glidewell’s competitors cannot describe their  
13 goods as what they are, i.e. “bruxer crowns” or “crowns for bruxers.” *Rudolph*,  
14 482 F.3d 1195, 1199, n.2, citing *Surgicenters*, 601 F.2d at 1017; *Filipino Yellow  
15 Pages*, 198 F.3d at 1151.

16 By asserting trademark rights to the term BRUXZIR against terms that  
17 include or derive from the term “brux”, Glidewell is attempting to unlawfully  
18 eliminate competition and increase its market share. This is counter to the  
19 purposes of enforcing trademarks and harms the public interest.

20 Accordingly, cancelation of Glidewell’s U.S. Trademark Registration for  
21 the mark BruxZir complies with public policy.

22 **V. CONCLUSION**

23 For the reasons discussed above, Keating respectfully requests that the  
24 court grant its motion for summary judgment canceling Glidewell’s U.S.  
25 Trademark Registration No. 3,739,663 for the mark BRUXZIR.

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1 Respectfully submitted,

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3

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